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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,618	05/21/2007	Roger Konig	SCHR 665	8472

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EXAMINER
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FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1792

NOTIFICATION DATE	DELIVERY MODE
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11/30/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@myerswolin.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,618	<b>Applicant(s)</b> KONIG, ROGER	
	<b>Examiner</b> William P. Fletcher III	<b>Art Unit</b> 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 26-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/23/2008</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Response to Amendment***

1. The amendment and remarks filed August 13, 2009, are noted with appreciation.
2. Claims 26-36 remain pending.

### ***Information Disclosure Statement***

3. The information disclosure statement filed December 23, 2009, has been considered by the Examiner.

### ***Response to Arguments***

4. The objection to the specification is withdrawn in view of the amendment.
5. The objections to the claims are withdrawn in view of the amendment.
6. With respect to the rejections under 35 USC 112, 1<sup>st</sup> paragraph, Applicant's statement *The invention will be explained in greater detail with an example of embodiment.* is noted. Nevertheless, the following example is only for a wood glaze and, while one skilled in the art might recognized that other wood glaze compositions may be functional, would not necessarily recognize that any and all other aqueous second coating compositions comprising an activator would be functional from this statement.
7. The rejections of claims 30 and 31 under 35 USC 112, 2<sup>nd</sup> paragraph, are withdrawn in view of the amendment.
8. The rejection of claim 26 under 35 USC 112, 2<sup>nd</sup> paragraph, is maintained. It is unclear how a composition can comprise both a lacquer and a binder. Usually, a

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lacquer composition is disclosed as comprising a binder, in addition to solvent, etc., and not as a component in addition to a binder.

9. With respect to the prior art, new grounds of rejection are set forth herein below in response to Applicant's amendment. It remains the Examiner's position that substitution of an aqueous system would have been obvious to one skilled in the art for at least the environmental reasons set forth in the prior Office action. While the Examiner notes Applicant's reason for the use of an aqueous system, Applicant is reminded that the reason or motivation to modify a reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant. See MPEP 2144(IV).

10. Finally, the Examiner notes that, if the presence of an organic solvent in the second composition is critical to the invention, as asserted by Applicant, it must be recited in the independent claim.

### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 26-39 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the second composition's comprising a low-viscosity commercially available glaze based on a water-soluble binder for wood sealing as an activator, does not reasonably provide enablement for the any and all activators

encompassed by the language of the claim. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. Claims 26 and 37

Applicant's broadest disclosure is of the second composition's comprising a low-viscosity commercially available glaze based on a water-soluble binder for wood sealing as an activator. This does not support the any and all activators encompassed by the claim limitation reciting a second composition comprising an activator. Possession of a species does not, necessarily, imply possession of the genus.

B. Claim 27

Similarly, Applicant's broadest disclosure is of the above-mentioned wood glaze, not the any and all glazes encompassed by this term, such as ceramic glazes.

C. Claim 28

Similarly, Applicant's broadest disclosure is of the above-mentioned wood glaze, not the any and all water-soluble acrylates encompassed by the claim limitation reciting a water-soluble acrylate.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 26-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 26 and 37

i. It is unclear what is meant by the composition's having a lacquer *and* a binder. The expected conventional recitation would be a lacquer *having or comprising* a binder. The Examiner has interpreted this claim as such.

ii. In claims 26 and 37, the phrase *the first coat* lacks antecedent basis.

iii. The term "minor" in claim 39 is a relative term which renders the claim indefinite. The term "minor" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear how small an amount constitutes a *minor* amount within the context of the invention.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claim 26, 27, 29-33, 36, 37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thacker et al. (US 2,612,456 A), as applied to claim 26 above, further in view of Inokami et al. (US 2003/0144455 A1).

- A. Thacker is applied herein again as set forth in the prior Office action.
- B. As noted previously, Thacker teaches that the lacquer may contain nitrocellulose (not soluble in water) or acrylic resin dissolved in toluol [2:30 ff.]
- C. This reference does not expressly teach that the lacquer is water soluble.
- D. Nevertheless, the binders disclosed by Thacker are merely exemplary and it is clear that any known, suitable binder may be utilized. It is known in the art to provide water-based formulations of acrylic resins in place of organic solvent-based formulations for environmental reasons. This is evidenced, for example, by Inokami at [0017].
- E. Consequently, it would have been obvious to one skilled in the art to modify the process of Thacker so as to provide, as the acrylic resin lacquer, a water-based acrylic lacquer in place of the organic solvent-based lacquer for environmental reasons such as reduction of VOCs released on drying and the health and safety of workers.

***Allowable Subject Matter***

17. Claims 28, 34, 35, and 38, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter: Thacker is the closest prior art and is limited to the disclosed vinyl copolymer organosol. As such, use of a water-soluble acrylate, a soft lacquer, or a fragranced soft lacquer, are neither taught nor suggested.

***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/William Phillip Fletcher III/**  
Primary Examiner

November 23, 2009